

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 3-8 are rejected under 35 U.S.C. 102 over the European patent '373.

Claim 2 is also rejected under 35 U.S.C. over the patent in view of the French patent '300.

The specification and the claims are also objected and rejected for formal reasons.

After carefully considering the Examiner's grounds for formal objections and rejections, applicant has amended the specifications and the claims. Also claim 1 has been amended to more clearly distinguish the present invention from the prior art.

The present invention as defined in claim 1 deals with a bearing element to connect a wiper blade to a hook portion of a wiper arm. The bearing element has two side walls which are connected to each other by a hub and several lateral struts. The hook portion of the wiper arm is

guided between the side walls of the bearing element. The main new feature of the invention is the clearance between the side walls being differently large. The different clearances are located to each other with respect to the hub at opposite sides, so that at the one side of the bearing element wiper arms with a larger width can be guided than at the opposite side.

The Examiner rejected the claims over the EP 0 655 373 A1. The reference discloses a bearing element with side walls which are connected to each other by a hub and lateral struts. So far as the side walls are able to guide the wiper arms, they have a same clearance to both sides of the hub and/or to the bearing surfaces at the lateral struts so that they can only match with one width of wiper arms. The hub and the lateral struts are so shaped that wiper arms with different bending radii and different material thickness can be used; however, no wiper arms with different widths. Contrary to the known bearing element the bearing element in accordance with the invention is designed so that it can be used in addition with wiper arms with two different widths. Thus the requirements for more cases of application can be covered by only one kind of bearing elements.

It is believed to be clear that the new features of the present invention as defined in the amended claim 1 are not disclosed in the reference and cannot be derived from it.

The same is true with respect to the French Patent '300, which also does not teach the new features of the amended claim 1.

In order to arrive at the applicant's invention from the teaching of this reference, the reference has to be fundamentally modified, so as to provide the features which are first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the reference does not disclose any hints or suggestions for such modification.

As explained herein above and disclosed in the specification, the present invention provides for the highly advantageous results, since it broadens the application of the device for differently wide wiper arms. These

advantageous results are not accomplished by the construction disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1 as amended should be considered as patentably distinguishing over the art and should be allowed.

Also, the features of claims 5 and 8 are not disclosed in the prior art, and these claims are patentable per se.

Reconsideration and allowance of present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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